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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/643,190 | 08/21/2000 | Norbert Ohlenbusch | P0663/7020 | 8702 |

7590

06/04/2002

Randy J Pritzker
Wolf Greenfield & Sacks PC
600 Atlantic Avenue
Boston, MA 02210

EXAMINER

VO, HIEN XUAN

| ART UNIT | PAPER NUMBER |
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2863

DATE MAILED: 06/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/643,190

Applicant(s)

OHLENBUSCH ET AL.

Examiner

Hien X. Vo

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 7. 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 1-103 are pending.
2. The prior art submitted on 04/09/2001 and 03/15/2001 has been considered as indicated on the enclosed copies of Form PTO-1449.

Specification

On page 1 of the specification, applicant is required to update the current status of the parent applications serial No. 09/547,975, 09/547,977 and 09/548,217. Correction is required

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);
In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re*
Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-103 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of U.S. Patent No. 6,052,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the subject application differ from the patented claims in having the phrase: "experienced the minimum degree of smoothness for at least the given period of time and identifying that the foot of the user is airborne" or the equivalent language. In contrast the Patent claims "using an output of motion sensing device that does not require compression forces

thereon to sense motion to determined a moment that the foot leaves the surface". In order to detect motion of a foot relative to a surface during a footstep taken by the person, applicant must include detection of acceleration, velocity, time, etc. Therefore, the subject claims are broader than the Patent claims. It would therefore have been obvious to modify the claims of Patent 6,052,654 to claim the more limited "a minimum degree of smoothness for a given period of time".

Conclusion

4. All claims are rejected.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sidorenko et al. (U.S. Patent No. 4,409,992) disclosed an electronic ergometer.

Flentov et al. (U.S. Patent No. 5,636,146) disclosed an apparatus and method for determining loft time and speed.

Purdy et al. (U.S. Patent No. 4,757,714) disclosed a speed sensor and head-mounted data display.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Hien Vo, whose telephone number is (703)308-5253. The examiner

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Art Unit: 2863

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can normally be reached on Monday-Friday from 9:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten, can be reached on (703)308-0719.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-7382 (for informal or draft
communications, please label "PROPOSED" or
"DRAFT")

Hand-delivered responses should be brought to Crystal Plaza 4, Arlington. VA.,
Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of
this application should be directed to the Group receptionist
whose telephone number is (703)308-0956.

HIEN VO
June 03, 2002



JOHN S. HILTEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800